

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1-2, 4-10 and 12-34.

The following claims are *independent*: 1, 33 and 34.

The following claims have previously been *cancelled* without prejudice or disclaimer: 3 and 11.

Please *amend* claims 1, 12-13, 22, 24, 28, 30, 33 and 34; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices, Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification, figures and claims, and that no new matter has been added by way of these amendments.

Priority

The Examiner asserts on page 4 of the Office Action that Applicant has not complied with one or more conditions for receiving benefit of an earlier filing date under 35 U.S.C. §119(e). Applicant respectfully traverses this objection, and is currently investigating the priority date of the application and will respond to the Examiner's objection in due course.

Double Patenting Rejection

Claims 1, 33 and 34 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 32, 33 and 34 of copending Application No. 10/633,080, claims 1, 10, 20 and 21 of copending Application No. 10/456,000, and claims 1, 12, 17 and 21 of copending Application No. 10/464,601. Applicant traverses the provisional statutory double-patenting rejections and submits that a Terminal Disclaimer may be filed if deemed to be required when the pending applications issue.

Claim Rejections - 35 U.S.C. § 101

The Office Action has rejected claims 1-2, 4-10 and 12-32 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant respectfully traverses this rejection. Applicant submits that there is no test for non-statutory subject matter that subjectively precludes the aforementioned claims. MPEP § 2106, Section IV, states “claims directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible for patent protection.” MPEP § 2106 also discusses “[w]hile abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be.”

Applicant submits that the elements recited in the claims are, in fact, directed to statutory subject matter and do not fall within the recognized Judicial Exceptions as merely abstract ideas (such as mathematical algorithms), natural phenomena, and/or laws of nature. Though Applicant respectfully traverses the Examiner’s rejection and reserves the right to argue patentability of the claims in their original form at a later time, Applicant has amended independent claim 1 to provide clarification and/or to better track business practices. Amended claim 1 recites, *inter alia*, “a processor implemented

method of managing risk related to the Gaming Industry”; “generating via the processor a risk quotient”; and "wherein calculating the risk quotient criteria comprises a processor-determined value". Applicant submits claims 2, 4-10, and 12-32, which depend directly or indirectly from independent claim 1, are directed to statutory subject matter for at least the reasons discussed above. Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific explanation describing how claim 1 is allegedly directed to non-statutory subject matter. Accordingly, for at least these reasons, Applicant submits that claims 1-2, 4-10 and 12-32 are directed to statutory subject matter and withdrawal of this ground of rejections is requested.

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 1-2, 4-5, 7, 9, 13-14, 18-28 and 30-34 under 35 U.S.C. § 103(a) as being unpatentable over Tengel et al., US Patent No. 5,940,812 (hereinafter “Tengel”), in view of Dave Berns' article, "Resort Owners Seek Loans", Los Vegas Review Journal, Nov. 16, 1999, pg 1.D (hereinafter “Berns”). Claims 6, 8, 10, 12 and 15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Tengel, in view of Berns, and in further view of "Casino Gambling in New Jersey", a report by the NJCCC, published January 1998 (hereinafter "NJCCC"). Claim 16 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Tengel, in view of Berns, and in further view of "Capitol Briefs", Arizona Daily Star, Feb 5, 1997, pg 3.B. (hereinafter "Briefs"). Claim 17 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Tengel, in view of Berns, and in further view of "FTC Settles with Debt Collection Agency", Credit Risk Management Reporter, Sep 5, 2000, vol. 10, Iss. 17, pg. 1 (hereinafter "FTC"). Claim 29 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Tengel, in view of Berns, and in further view of Examiner's Official Notice.

Applicant respectfully traverses these rejections and submits that a *prima facie* showing of obviousness has not been made and that the applied references, taken alone or in combination, fail to discuss or render obvious every element of each pending claim.

Moreover, the Examiner asserts that Applicant's traversal of official notice in the Office Action dated September 18, 2008 is inadequate "since they have failed to argue why the Official Notice statements(s) are not to be considered common knowledge or well known in the art" (see Office Action, page 3). Applicant respectfully disagrees, and submits that on page 13 of the Amendment/Response dated March 18, 2009, Applicant asserts that the Examiner has to establish that the asserted element would have been well known to "one of ordinary skill in the art, at the time of the invention" within the context of the recited claim elements (see Amendment/Response dated March 18, 2009, page 13, line 6). As such, Applicants submit that the Examiner has employed impermissible hindsight by merely concluding that the claimed element(s) allegedly "was old and well known". Further, Applicant respectfully submits the Examiner has not defined the level of ordinary skill in the art at the time the invention was made within the context of the claimed invention, much less "cast the mind back to the time the invention was made ..., to occupy the mind of one skilled in the art" [*W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)]. As such, Applicant submits that the claimed element(s) would not be "capable of instant and unquestionable demonstration as being well known" to one of ordinary skill in the art at the time the invention was made within the context of the claimed invention, as per MPEP 2144.03(A) to establish a viable basis for official notice. Therefore Applicant, again, respectfully traverses the Examiner's Official Notice (and any other instances of official notice in the Office Action) and requests the Examiner to provide explicit documentary evidence in support of the assertion that the

claim element is allegedly unquestionably demonstrable as being old and well known as one of ordinary skill in the art at the time of the invention would understand within the context of the claims, as required by the MPEP.

Moreover, Applicants submit that a *prima facie* case of obviousness has not been established.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line numbers where appropriate;

(B) the differences in the claim over the applied reference(s);

(C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and

(D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

(MPEP § 706.02(j))

Applicant submits that the rejections in the pending Office Action do not establish each of these requirements. More specifically, Applicant submits that, by over-generalizing the applied references, the rejections in the Office Action do not establish at least either of elements (A) and (B) of a *prima facie* case of obviousness. Furthermore, Applicants reiterate the arguments presented in the Amendment/Response dated March 19, 2009, and submit the Examiner has not established that the cited references are combinable by one of ordinary skill in the art at the time of the invention to result in the claimed elements.

Independent claim 1 recites, *inter alia*:

A processor implemented method for managing risk related to the Gaming Industry, the method comprising:

...

receiving into the computer system data descriptive of Gaming Industry related informational artifacts with content related to at least one of: reputational risk, legal risk, regulatory risk, and risk related to monetary costs to defend an adverse position.

Applicant submits that the cited references, taken alone or in combination, fail to discuss or render obvious the claimed "at least one of: reputational risk, legal risk, regulatory risk, and risk related to monetary costs to defend an adverse position", as recited in independent claim 1.

The Examiner relies on Tengel as allegedly discussing the claimed element as recited in independent claim 1. Pages 8-9 of the pending rejection state:

Tengel teaches ... receiving into the computer system ... (see col 5, line 27 - col. 6, line 45, note that the loan acceptance criteria set by the lender include trade entry, current years in residence, self-employment status, credit limit, CLTV. Note that these refer to characteristics of the borrower) (Office Action, § 13, pages 8-9)

Applicant respectfully traverses, and submits that Tengel and/or Berns, taken alone or in combination, do not discuss or render obvious at least the claimed elements as recited in independent claim 1.

Instead of the Examiner's characterization of Tengel applied to independent claim 1, Applicant submits the cited portions of Tengel simply discuss "loan acceptance criteria" (Tengel, col. 6, line 46), as the Examiner has acknowledged in the Office Action (see Office Action, § 13, p. 9). Applicant submits Tengel uses these "loan acceptance criteria" to calculate a "score [of] the potential borrower" (Tengel, col. 6, line 51). Tengel determines the borrower-score to assess "the risk of default the borrower presents to the lender" (Tengel, col. 11, lines 60-61). However, Applicant respectfully submits that Tengel's "risk of default the borrower presents to the lender" is fundamentally different

from the claimed "risk related to ... monetary costs to defend an adverse position", as recited in independent claim 1. Furthermore, Applicant submits Tengel's "loan acceptance criteria" also does not discuss or render obvious at least the claimed "reputational risk", "legal risk" and/or "regulatory risk", as recited in independent claim 1.

Furthermore, Applicant submits that Berns' high level discussion of financially-failing "resort owners seek[ing] loans" (see Berns, Title, Abstract), fails to remedy the deficiencies identified above in Tengel with regard to independent claim 1.

The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." [§ 2143.03, emphasis added]. Applicant submits the pending rejection has failed to consider "every limitation in the claim" and "[a]ll words in [the] claim" in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). Accordingly, Applicant submits the pending rejection has not established a *prima facie* case of obviousness. Should the Examiner maintain the rejection, Applicant respectfully requests additional clarification, with particularity, as to how the Examiner believes Tengel's "loan acceptance criteria" discusses or renders obvious the claimed "at least one of: reputational risk, legal risk, regulatory risk, and risk related to monetary costs to defend an adverse position", as recited in independent claim 1.

Although of different scope than claim 1, Applicant submits independent claim 33 is patentable over Tengel, in view of Berns, taken alone or in combination, for at least similar reasons as discussed above identifying deficiencies in the applied references with regard to independent claim 1. For example, independent claim 33 recites, *inter alia*:

A computerized system for managing risk associated with the Gaming Industry, the system comprising:

... a processor ... configured to issue a plurality of processing instructions [to]:

... receive into the computer system data descriptive of Gaming Industry related informational artifacts with content related to at least one of: reputational risk, legal risk, regulatory risk, and risk related to monetary costs to defend an adverse position; ...

Applicant respectfully submits at least these claim elements from independent claim 33 are not discussed or rendered obvious by Tengel and/or Berns, taken alone or in combination, for at least the reasons discussed above.

Although of different scope than claim 1, Applicant submits independent claim 34 is patentable over Tengel, in view of Berns, taken alone or in combination, for at least similar reasons as discussed above identifying deficiencies in the applied references with regard to independent claim 1. For example, independent claim 34 recites, *inter alia*:

A processor-readable medium storing a plurality of processor-issuable instructions, comprising instructions to:

... receive into the computer system data descriptive of Gaming Industry related informational artifacts with content related to at least one of: reputational risk, legal risk, regulatory risk, and risk related to monetary costs to defend an adverse position; ...

Applicant respectfully submits at least these claim elements from independent claim 34 are not discussed or rendered obvious by Tengel and/or Berns, taken alone or in combination, for at least the reasons discussed above.

Furthermore, Applicant submits that claims 2, 4-10 and 12-32, which depend directly or indirectly from independent claim 1, are also not discussed or rendered obvious by the cited references, taken alone or in combination, for at least similar reasons as those discussed above identifying deficiencies in the applied references with regard to independent claim 1.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of these grounds of rejections.

CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-2, 4-10 and 12-34, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements and/or bases for rejection were not discussed as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art and reserves the opportunity to more particularly traverse, remark and distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to an Office Action objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Office Action objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

AUTHORIZATION

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209-314CP1. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209-314CP1.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
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Dated: August 25, 2009

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